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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,792	05/09/2005	Jean-Pierre Radenne	003D.0032.U1(US)	6292
29683	7590	02/27/2006	EXAMINER	
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			CHU, CHRIS C	
			ART UNIT	PAPER NUMBER
			2815	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,792

Applicant(s)

RADENNE ET AL

Examiner

Chris C. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 14 is/are pending in the application.
- 4a) Of the above claim(s) 5 - 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on January 11, 2006 is acknowledged. The traversal is on the ground(s) that:

(A) Applicant has argued that since the international phase examiner believed that the Group I (claims 1 – 4) and the Group II (claims 5 – 13) of the inventions are so linked as to form a single general inventive concept, there is no unity of invention restriction raised during the international phase of this application. Therefore, USPTO should abide by the international phase examiner's determination to avoid the violation of the PCT treaty. This is not found persuasive because PCT Rule 13.2(ii) clearly indicates that the process and device have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e). However, the Group I and Group II do not have unity of invention because the product as claimed can be made by a materially different process such as using a blanket deposition process to form a dielectric/mask layer on the substrate instead of attaching mask tape on the substrate. Also, the process as claimed can be used to make a materially different product such as the final product of the mask having a shape that is not a parallelepiped shape (see the mask 25 in Hoppe et al.; U. S. Pat. No. 5,637,858).

(B) Applicant argues that claim 1 is linked to claim 5. This is not persuasive because the single general inventive concept in this invention is the "mask" formed on a substrate and that special common feature in Group I and Group II does not have technical relationship among

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the inventions. See MPEP § 1850 for a detailed discussion of Unity of Invention. As explained in the previous paragraph, the claim 5 is not the necessary process of making for the claim 1 and the claim 1 is not the necessary product made by the process as set forth in claim 5. Thus, claim 1 is not linked to claim 5 and the claim 5 is not linked to the claim 1.

(C) Applicant has argued that there is no undue burden for the U. S. examiner to examine all of the claims in the application. This is not found persuasive. Since each invention requires separate examination and search in different classes and subclasses (i.e., 257 class and 438 class), the examination of the entire claims in the application is a serious burden.

(D) Applicant has argued that the examiner has not identified any different classifications for the two groups of claims to justify the restriction requirement. This is not found persuasive because the identification of classifications for the two groups of claims is not a requirement in the National stage case.

(E) Newly submitted claim 14 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant elected Group I, device claims and claim 14 is not a device claim.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 14 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The abstract of the disclosure is objected to because “Figure 1” shouldn’t be under the abstract. Correction is required. See MPEP § 608.01(b).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “4” has been used to designate both “contact area” on page 6, line 25 and “printed circuit” in page 7, line 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1 – 4 are objected to because of the following informalities:
- (A) In claim 1, line 4, “characterised” should be --characterized--, a spelling mistake.
 - (B) In claim 2, line 1, “characterised” should be --characterized--.
 - (C) In claims 3 and 4, line 2, “characterised” should be --characterized--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Regarding claim 2, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogami et al. (U. S. Pat. No. 5,975,420) in view of Hoppe et al. (U. S. Pat. No. 5,637,858).

Regarding claim 1, Gogami et al. discloses in e.g., Fig. 9C an electronic microcircuit module (110; column 12, line 15) including

- a substrate (111; column 12, line 17),

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- at least one contact area (115; column 12, line 18) on a first face of this substrate (see e.g., Fig. 9C),
- a second face of this substrate (111) capable of accommodating an integrated circuit (112; column 12, line 21), characterized in that includes a parallelepiped shape (see e.g., Fig. 9B and column 2, line 29),
- a first adhesive means (the attaching material between the frame 114 and the IC chip 112 to the substrate 111; column 12, lines 22 – 24 and column 7, lines 6 – 10) to retain a first face of a mask (114; column 12, line 23) in position against the second face of the substrate (see e.g., Fig. 9C),
- the mask (114) delimiting the parallelepiped (see e.g., Fig. 9C and column 2, line 29) being perforated to form a window (the space formed by the frame 114; see e.g., Fig. 9C and column 12, lines 28 – 30) around the integrated circuit (112).

Gogami et al. does not disclose a second adhesive means on a second face of the mask. Hoppe et al. teaches in e.g., Fig. 6 a second adhesive means (29; column 4, lines 7 and 8) on a second face of a mask (25; column 3, line 66). It would have been obvious to one of ordinary skill in the art at the time when the invention was made to apply the second adhesive means of Hoppe et al. on the second face of the mask of Gogami et al. as taught by Hoppe et al. to attach the mask on the bottom of a recess in the card body (column 4, lines 6 – 9).

Regarding claim 3, Gogami et al. discloses in e.g., Fig. 9C characterized in that the mask (114) has a thickness, defined with regard to the second face of the substrate (111) on which it is mounted, greater than the height of the integrated circuit (112; see e.g., Fig. 9C).

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Regarding claim 4, Gogami et al. discloses in e.g., Fig. 9C characterized in that the first adhesive means (the attaching material between the frame 114 and the IC chip 112 to the substrate 111; column 12, lines 22 – 24) enables the integrated circuit to be retained on the substrate.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gogami et al. and Hoppe et al. as applied to claim 1 above, and further in view of Atsumi (U. S. Pat. No. 5,736,781).

While Gogami et al. and Hoppe et al. disclose the use of the mask and a card (101; column 1, lines 35 – 36), Gogami et al. and Hoppe et al. do not disclose the material of the mask to be identical to that of a card's material (i.e., polyvinyl chloride; column 1, lines 35 – 36 of Gogami et al.). Atsumi teaches in e.g., Fig. 2 a mask (12; column 3, lines 16 and 17) being made from a material (i.e., polyvinyl chloride) identical to that of a card (40; column 3, lines 61 and 62) provided receive a module (1; column 4, line 8). It would have been obvious to one of ordinary skill in the art at the time when the invention was made to apply the polyvinyl chloride of Atsumi as the specific material to form the mask of Gogami et al. and Hoppe et al. as taught by Atsumi to provide similar rigidity as the card body (column 3, lines 16 and 17).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yanaka et al., Yamamoto, Uden, Ugon, Thevenot et al. and Hida et al. disclose an IC module in a recess of an IC card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris C. Chu whose telephone number is 571-272-1724. The examiner can normally be reached on 11:30 - 8:00.

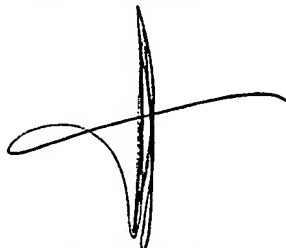
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chris C. Chu
Examiner
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c.c.
Thursday, February 16, 2006

A handwritten signature in black ink, appearing to read 'KENNETH PARKER', with a large, stylized loop on the left side.

KENNETH PARKER
SUPERVISORY PATENT EXAMINER